

Docket No.: 2091-0300P
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Kazuto WASHIO

Application No.: 10/694,938

Confirmation No.: 6148

Filed: October 29, 2003

Art Unit: 2628

For: METHOD, APPARATUS, AND PROGRAM
FOR IMAGE PROCESSING

Examiner: R. R. Yang

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

April 2, 2007
(Monday after due date)

Sir:

INTRODUCTORY COMMENTS

Applicant respectfully requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed concurrently with a Notice of Appeal.

The review is being requested for the reasons set forth on the attached five (5) sheets.

ARGUMENTS

Applicant respectfully submits that the Examiner has made the following clear errors:

- (1) The Examiner has made a clear error in interpreting and applying the prior art in rejecting claims: (a) claims 1-15 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,684,087 to Yu et al. (hereafter *Yu*) in view of U.S. Patent No. 6,940,526 to Noda et al. (hereafter *Noda*); and (b) claims 16-18 under 35 U.S.C. §103(a) as being unpatentable over Yu in view of Noda and further in view of U.S. Patent No. 6,639,603 to Ishii (hereafter *Ishii*); **and**
- (2) The Examiner has made a clear error in qualifying *Noda* as prior art.

The Examiner has Failed to Establish Prima Facie Obviousness by Failing to Provide References that Teach or Suggest All of the Claim Elements

Applicant respectfully submits that the Examiner has made a clear error in interpreting and applying the prior art.

For example, with regards to independent claims 1, 4 and 7, a processed image data set is generated by cutting out an area from an image represented by a selected one of the image data sets according to the changeable image area that has been specified, wherein the changeable image area is arbitrarily designated by a user while maintaining the specification of the screen of the mobile terminal.

The Examiner *concedes* that *Yu* fails to disclose that the image area is a changeable image area wherein the size and the position of the changeable image area are arbitrarily designated by a user while maintaining the specification of the screen of the mobile terminal (see final Office Action, page 4). However, in an attempt to show this feature the Examiner imports *Noda*.

Specifically, the Examiner alleges that such a feature is well known in the art as taught by Noda's image synthesizing method for a communication terminal in which "the operator may change the position and size of the crop boundary 84 relative to the second image 88 to designate an area to be pasted in the inner frame 47b". (see final Office Action, page 4).

However, Applicant respectfully submits that a close review of *Noda* reveals a very distinguishable method/apparatus.

For example, *Noda* merely teaches an apparatus in which *a main image is superimposed on a background image*. When superimposing, the main image is cropped and pasted on the background image maintaining the aspect ratio of the cropped main image. The aspect ratio of the main image is designated by a user to appropriately fit the main image on the background image.

In contrast, the aspect ratio of an image of the present invention is designated according to *the specification of a screen of a mobile terminal* to which an image would be transferred. The aspect ratio in the present invention is not adjusted by a *user*, as done in *Noda*. Furthermore, the present invention is directed to a system that includes a PC, with which a user can manipulate an image, and a server, which is connected to the PC via a network. In the present invention, the information regarding the aspect ratio of a screen of a *mobile terminal is stored in the server*. In the present invention, a user does not necessarily have to designate the aspect ratio because such information is supplied from the server.

In other words, *Noda* fails to disclose designating an aspect ratio of an image *according to the specification of a screen of a mobile terminal* to which an image would be transferred. Instead, *Noda* merely crops and pastes a main image onto a background image while maintaining the aspect ratio of the cropped main image. *Noda* fails to consider the specification of a screen of a mobile terminal in designating the aspect ratio. *Noda* merely relies upon the user to designate the aspect ratio.

Accordingly, Applicant respectfully submits that one of ordinary skill in the art would not be motivated to combine *Yu* with *Noda*, because *Noda* is completely silent about cropping an image having an aspect ratio corresponding to that of a screen of a mobile terminal.

For at least the reasons noted above, Applicant respectfully submits that the combination of *Yu* and *Noda* fails to teach or suggest that the size and the position of a changeable image area is arbitrarily designated by a user while maintaining the specification of the screen of the mobile terminal.

Applicant also respectfully submits that Ishii fails to make up for the deficiencies found in Yu and Noda. Applicant respectfully submits that neither *Yu*, *Noda* nor *Ishii*, taken singularly or in combination, (assuming these teachings may be combined, which Applicant does not admit) teach or suggest a changeable image area that is arbitrarily designated by a user to determine size and position.

For at least the reasons noted above, applicant respectfully submits that contrary to the Examiner's beliefs, *Noda* fails to make up for the deficiencies found in each of *Yu* and *Ishii*.

Noda is Disqualified as Prior Art

Applicant respectfully submits that the Examiner has made a clear error in qualifying *Noda* as prior art.

Specifically, applicant respectfully points out to the Examiner that, according to MPEP §706.02(I)(1), subject matter which was prior art under former 35 U.S.C. 103 *via* 35 U.S.C. 102(e) is now *disqualified as prior art* (emphasis added) against the claimed invention if that subject matter and the claimed invention “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.”

Applicant respectfully advises the Examiner that the present application and the cited reference *Noda* were, at the time the invention was made, both owned by the same person or subject to an obligation of assignment to the same person. The required evidence of common ownership is shown in the Assignment papers filed on October 29, 2003 in the present application, depicting “Fuji Photo Film Co., Ltd.” as the common owner between the present application and the cited *Noda* (USP 6,940,526) reference.

In other words, Application 10/694,938 and Patent 6,940,526 were, at the time the invention of Application 10/694,938 was made, both owned by Fuji Photo Film Co., Ltd..

Accordingly, Applicant respectfully submits that the secondary reference, USP 6,940,526 to *Noda et al.*, used for the 103(a) rejection in the final Office Action is now *disqualified as prior art* against the claimed invention.

Applicant respectfully submits that as conceded by the Examiner, USP 6,684,087 to *Yu* fails to make up for the disqualification of USP 6,940,526 to *Noda*. As such, Applicant respectfully submits that claims 1-18 are allowable, for at least the reasons set forth above, over the cited references.

Accordingly, withdrawal of the rejections of claims 1-18 under 35 U.S.C. §103(a) in the November 1, 2006 final Office Action is respectfully solicited.

Conclusion

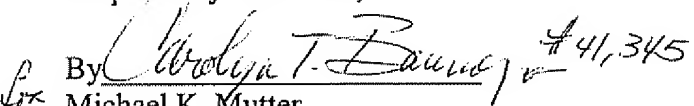
In view of the above foregoing, Applicant respectfully submits that the application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Carolyn T. Baumgardner (Reg. No. 41,345) at (703) 205-8000 **to schedule a Personal Interview**.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: April 2, 2007

Respectfully submitted,

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